IN THE

Supreme Court of the United States,

OCTOBER TERM, 1898.

WILLIAM A. BRADY,
Plaintiff in Error,

against

AUGUSTIN DALY.

No. 273.

Brief in reply to supplemental brief of defendant in error.

The defendant in error has filed an answering brief and a supplemental brief. The only portion of his two briefs calling for a reply is his contention that the Circuit Court has jurisdiction of actions to recover penalties.

(*a.*) After citing some of the early statutes on the subject of copyright counsel asserts that out statement that

> " Prior to the Act of 1870 the general lan-
> " guage vesting the jurisdiction in the Circuit
> " Courts over all actions, suits, controversies
> " and cases at law or in equity, arising under
> " the patent or copyright laws of the United
> " States, was held not to confer jurisdiction
> " over actions to recover penalties,

is without authority, since the said general language was not employed to vest jurisdiction prior to the Act of 1870.

He has evidently overlooked the Act of 1819 (3 St. at large, page 481), which is not cited or referred to by him. That act provides:

> "That the Circuit Courts of the United States
> "shall have original cognizance, as well in
> "equity as at law, of all actions, suits, contro-
> "versies and cases arising under any law of
> "the United States, granting or confirming to
> "authors or inventors, the exclusive right to
> "their respective writings, inventions and
> "discoveries. * * * "

The substance of said act is incorporated in the Patent Act of 1836, so far as it relates to inventors (5 St. at large, 124).

It will be noticed that the language used by us and criticised by counsel is almost *verbatim* the language used in the Act of 1819.

In Stephens *vs.* Gladding, 17 How., 447, this Court, referring to the act above cited, says:

> "There is nothing in this Act of 1819, which
> "extends the equity powers of the Courts to
> "the adjudication of forfeitures; it being
> "manifestly intended that the jurisdiction
> "therein conferred should be the usual and
> "known jurisdiction exercised by Courts of
> "equity for the protection of analogous
> "rights." * * *

Drone in his work on Copyright, at page 548, says:

"The law as thus expounded by the Supreme "Court in 1854, has not been changed by any "statute since passed. The sections of the "copyright law, which impose forfeitures and "penalties, do not specify in what court they "shall be recovered. Section 529 of the Re-"vised Statutes gives to the Circuit Courts of "the United States original jurisdiction of all "suits at law or in equity, arising under the "copyright laws, and Section 4970 simply em-"powers Circuit Courts and District Courts "having jurisdiction of Circuit Courts, to "grant injunctions to prevent the violation of "copyright."

We thus find that the language of the Act of 1819 is in substance, as broad as that found in subdivision 9 of Section 629 of the Revised Statutes giving the Circuit Courts jurisdiction "of all suits at law or in equity arising under the patent or copyright laws of the United States."

(*b.*) Counsel lays stress upon the fact that the word "exclusive" in the Act of ~~1897~~ 1789 giving the District Court jurisdiction of actions for penalties and forfeitures incurred under the laws of the United States, is omitted from Section 563, Clause 3 of the Revised Statutes and argues that the Revisors omitted that word for the reason that they had vested in the Circuit Court jurisdiction over penalties in patent and copyright cases.

In Lees *vs.* U. S., 150 U. S., 476, this Court, at page 478, had occasion to speak of the omission of this word, saying:

"From the earliest history of the govern-

" ment, the jurisdiction over actions to recover
" penalties and forfeitures has been placed in
" the District Court. The ninth section
" of the Judiciary Act of September 24,
" 1789, 1 Stat., 73, 76, c. 20, provided as
" follows: 'The District Court shall have
" 'exclusive original cognizance * * *
" 'of all suits for penalties and forfeitures in-
" 'curred under the laws of the United States.'
" While in the Revised Statute the word 'ex
" clusive' was omitted, the language was not
" otherwise substantially changed. It is true
" that in some cases jurisdiction over matters
" of penalty and forfeiture has been committed
" to the Circuit Court, *but this was always*
" *done by special act and does not otherwise*
" *affect the proposition that the general juris-*
" *diction over actions for penalties and for-*
" *feitures has been and is vested in the Dis-*
" *trict Court.* Hence, when as here, a statute
" imposes a penalty and forfeiture, jurisdiction
" of an action. therefor would vest in the Dis-
" trict Court, unless it is in express terms
" placed exclusively elsewhere" (italics ours).

(*c.*) Counsel says that Lees *vs.* U. S., holds only that the jurisdiction of District Courts is not necessarily ousted when the right to recover a penalty is given to the Circuit Court. We do not so read that decision. In that case the Act imposed a penalty and provided that it may be recovered "as debts of like amount are now recovered in the Circuit Courts of the United States," and the question being whether said Act vested jurisdiction in the Circuit Courts, this Court held,

"that the words seem to refer to the form of the "action, rather than to the forum. When it "is remembered that a penalty may be recovered "by an indictment or information in a criminal "action, or by a civil action, in the form of an ac- "tion of debt, and also that the Circuit Courts of "the United States are, as contradistinguished from "the District Courts, the Federal Courts of orig- "inal civil jurisdiction, the significance of this "clause is clear. It in effect provides that, "although the recovery of a penalty is a proceed- "ing criminal in its nature, yet, in this class of "cases it may be enforced in a civil action, and in "the same manner that debts are recovered in the "ordinary civil courts."

In U. S. *vs.* Mooney, 116 U. S., 104, this Court, construed the Act of 1875, which gave the Circuit Court original cognizance concurrent with the Courts of the several States, of all suits of a civil nature, at law or in equity, where the matter in dispute, exceeds, exclusive of costs, the sum of five hundred dollars, and arising under the Constitution or laws of the United States, etc., as not covering or embracing actions for a penalty.

This language is as broad as that found in the copyright act of 1819, or the Revised Statutes, Section 629, Clause 9. It seemed to cover all cases of a civil nature, at law or in equity, but still it was held, that as it did not specifically refer to penal actions, criminal in their nature, it did not affect the jurisdiction of the District Courts over actions of that character.

(*d.*) Counsel refers to several actions of which he says, the Circuit Courts assumed jurisdiction, with the tacit approval of this Court, but in none

of those cases was the question under discussion raised or presented for determination.

(*e.*) In reply to counsel's suggestion that Taft *vs.* Lithographic Co., 37 Fed., 726, referred to in our brief (p. 18), has never been overruled or questioned, it is a sufficient answer to say that it was never before any Court for review, and has never been cited or followed in any case to which our attention has been called.

Respectfully submitted,

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Of Counsel.